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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,560	06/27/2003	Paul-Andre Roland Savoie	LOJACK-131J	5456
32488	7590	11/17/2005	EXAMINER	
IANDIORIO & TESKA 260 BEAR HILL ROAD WALTHAM, MA 02451-1018			BEHNCKE, CHRISTINE M	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/838,560

Applicant(s)

SAVOIE, PAUL-ANDRE ROLAND

Examiner

Christine M. Behncke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the Remarks filed 03 September 2005, in which claims 1-31 were presented for reexamination and reconsideration.

#### ***Reissue Applications***

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration failed to fully identify at least one error being relied upon as a basis for the reissue and that it is indeed an appropriate error for reissue (37 CFR 1.175 (a)(1)). Specific changes or amendments to the claims must be identified. If new claims are presented, the differences between the original claims and the new claims must be pointed out. Applicant is correct that one basis for filing a reissue application is that the claims were originally filed too narrow or too broad. Applicant has stated the reason to be "we believe we are entitled to patent protection on a method in which we are obtaining locating information concerning a locating cellular transceiver". The Examiner respectfully disagrees that this is an adequate error. The declaration quoted above is the basis for the reissue but does not state a specific error that is being sought to be corrected. Within the original patented claims, claims 1-10, a method for obtaining locating information concerning a locating cellular transceiver was already claimed and patented (claim 1: locating a stolen vehicle with a locating cellular transceiver, lines 1-3). The original claims were limited to the embodiment of a vehicle. If the Applicant believes that the error is that they were entitled to patent protection on a method outside or broader than a locating cellular

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transceiver located in a vehicle the Applicant must clearly state so. The omission of the feature in the declaration does not clearly differentiate an error of the original patent to make the original patent wholly or partly inoperative or invalid.

3. Claims 1-31 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

### ***Response to Arguments***

4. Applicant's arguments filed 03 September 2005 have been fully considered but they are not persuasive.

5. Applicant contends that the claims of the reissue application are described in the original patent specification and are enabled by the original patent specification.

Applicant contends that the fact that amended claims 11 and 22 contain methods of locating information concerning a cellular transceiver that is silent about the power supply is not relevant because 1) the original claims are also silent about the power supply of the transceiver and 2) the original specification is not limited to a car battery as the power source.

6. The Examiner respectfully disagrees. The Examiner does note that the original claims are also silent about the power supply of the transceiver, but the original claims clearly and distinctly limit the cellular transceiver to being located within a vehicle.

Specifically, the preamble is for "locating a stolen vehicle" and the bodies of the claims consistently refer to said stolen vehicle. Amended claims 11 and 22 contain no such

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limitation and are therefore considered to encompass non-vehicle embodiments, such as a variety of objects, persons or animals. Support for the non-vehicle embodiments is not founded in the originally filed disclosure (Please see the rejection below for further specifics).

7. Applicant contends that the original specification is not limited to a vehicle and refers to the other power source and the phrase "such as" in the specification. The Examiner respectfully disagrees. The Examiner does note that the phrase "such as" indicates an example, but the vehicle embodiment is the **only** example and embodiment disclosed, suggested or taught by the original specification. Support and description only of a species does not constitute a supportive description and thus entitlement of a genus of which it is a part. Further, the Examiner assumes Applicant's vague reference to other power sources refers specifically to Battery Backup 32 in Figure 3a or to Power Supply 33 in Figure 3a and the related description. The Examiner contends these further power sources do not indicate that a power source outside of a vehicle is supported by the original specification. As shown clearly in Figure 3a, both the Battery Backup 32 and Power Supply 33 are connected to the Car Battery. Both sources are located within the vehicle and further description of the drawings only indicates wherein those power sources and others are connected to a vehicle. Therefore the amended claims 11 and 22 of the broader embodiment lack sufficient support in the originally filed specification. (Please see the rejection below for further specifics.)

8. Applicant contends that the commonly owned referred to Patent 6,498,565 (Patent '565) has no bearing on the intent of the original specification. Applicant

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supports this position by arguing that at the time Patent '565 was filed the applicant had not filed the subject reissue application and that the language referred to by the Examiner was written before the applicant had filed the subject reissue application.

9. The Examiner agrees that Patent '565 was filed before the subject reissue application. The Examiner further does not disagree with Applicant's admission that the referred language was written before the filing of the subject reissue. However, the Examiner respectfully disagrees that previous fact and admission indicate that the patent has no bearing. The admission that the referred to patent was written and filed after the original disclosure, that discloses only the embodiment of the transceiver with a vehicle, supports the contention that at the time of filing the original disclosure the Applicant's did not have the intent for that particular invention to claim wherein the transceiver was modified to locate a variety of objects, persons, or animals. The fact that a separate and distinct invention, Patent '565, was filed, prosecuted and issued more than a year after the invention of the current reissue was patented, is a strong indication that the Applicant's at the time of the original filing had no intention of claiming the subject matter of the later patent and did not at that time have possession of the broader subject matter. The fact that a second patent was sought for on the embodiment using: "a two-way tracking system similar to the one disclosed in U.S. Pat. No. 5, 895,436" ('565: Column 1, lines 39-41) indicates that the Applicant's recognized that the embodiment was separate and distinct from the originally filed disclosure. The Examiner contends that the referred to patent has strong bearing on the intent of the

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original specification specifically because of Applicant's admission that it was written, filed, and thereby invented, after the original filing of the subject application.

***Claim Rejections - 35 USC § 251***

10. Claims 11-31 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: page 3, Column 4, line 1- page 4, Column 5, line 42. As stated in the MPEP 1411.02, the claims in a reissue application must be for the subject matter which the applicant had the right to claim in the original patent. The subject matter currently at issue is considered new matter by virtue of the omission of a feature in a method; specifically the feature omitted is a vehicle. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942). The broader subject matter at issue is not a portion of the original invention that was intended or sought to be covered by the original patent, further the broader subject matter was not even suggested in the original patent.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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that was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. The added material which is not supported by the prior patent in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is as follows:

13. The amended independent claims 11 and 22 contain methods of locating information concerning a cellular transceiver that are broader than the originally filed independent claims 1 and 9. The Examiner contends that the implementation of the vehicle locating cellular transceiver to a smaller mobile unit or other embodiment not restricted to a vehicle, such as for a person or animal is patentably distinct and was not possessed by the applicant at the time of the original filing. It is the Examiner's position that the original disclosure only supports a vehicle locating cellular transceiver.

14. The claimed subject matter originally filed was a method and system of locating a stolen vehicle provided with a locating cellular transceiver. The originally filed disclosure was orientated and fully supported that the claimed transceiver was located and restricted to a vehicle or vehicle use.

The support for this contention is demonstrated by:

a. Wherein the originally disclosed transceiver was directly connected to the vehicle's power source, a constant 12-volt power source, such as a car battery (Column 5, lines 7-11). The specification does indicate that a power source another power source can be used. However, the **only** other indicated and



supported external power source for the transceiver is back-up battery that is clearly connected to the main car battery (figure 3a). Further, in the original specification this other external power source only supports that this other battery (back-up battery 32) is "to prevent the transceiver 30 from being disabled if the cables to the car battery are disconnected" (Column 5, lines 9-11). Further, the internal power supply of the cellular transceiver, power supply 33, is also clearly connected to the car battery and back-up battery located in the vehicle (figure 3a).

b.      Wherein the originally disclosed locating cellular transceiver antenna is restricted to a vehicle. Antenna 31 is shown in Figure 3a connecting to the transceiver system, wherein "Antenna 31 need not be connected to the standard 3 dB whip-type antenna normally mounted on a window the vehicle. **In particular, antenna 31 is adapted to be inconspicuously laid out inside the vehicle.**" (Column 5, lines 3-7).

c.      Wherein the original disclosure does not support or disclose any further embodiments particularly wherein the locating cellular transceiver is not connected, related or used in conjunction with a vehicle. Figures 2b-4b only shown and describe the locating cellular transceiver as being embodied or in conjunction with a vehicle: "in FIGS. 3b and 3c, the locating cellular transceiver of vehicle 40..." (Column 6, lines 19-21). Further, there is no suggestion to a person of ordinary skill in the art that applicants had possession in the original disclosure of the cellular transceiver outside or separate from the vehicle.

15. The Examiner further refers to currently held US Patent No. 6,498,565 (further referred to as Patent '565) filed February 6, 2001 that concerns a method and a system for tracking an object, person or animal that is provided with a wireless transceiver.

Patent '565 shares a common inventor with the pending application, André Eric Boulay, and has a common assignee, Boomerang Tracking, Inc. but does not share any priority relation. As admitted by the applicants of Patent '565, the patented invention is an improvement over the pending application and uses a similar two-way tracking system:

"One of the objects of the present invention is to provide a two-way tracking system similar to the one disclosed in U.S. Pat. No. 5,895,436, using an existing wireless network to locate a variety of objects, persons or animals." (Column 1, lines 39-42)

Patent '565 discloses wherein the locating wireless transceiver can be installed in a vehicle, similar to the pending application (Column 3, lines 9-16). But further discloses wherein the wireless transceiver is not limited to a vehicle, "but can also be worn by a person, an animal or be installed in or on almost any object" (Column 3, lines 9-11).

Patent '565 further distinguishes itself by stating:

"One of the main issues of that patent [Patent 5,895,436 under reissue] is conserving the integrity and security of the on-board system. In fact, the on-board system must be hidden from view, so as to prevent a potential thief from disarming the system" (Column 1, lines 33-36).

16. In light of the original specification and the admissions made in Patent '565 the Examiner contends that the subject matter extending the claimed tracking technology for a stolen vehicle to as scope that would include for a person, animal or other object

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was not known or possessed at the time of the originally filed application. Therefore, the Examiner contends that the amended claims lack sufficient support in the original patent specification and further the original application and the referred to patent demonstrate applicant's lack of intent to claim the subject matter currently presented in the reissue application.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine M. Behncke whose telephone number is (571) 272-8103. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:30 PM.

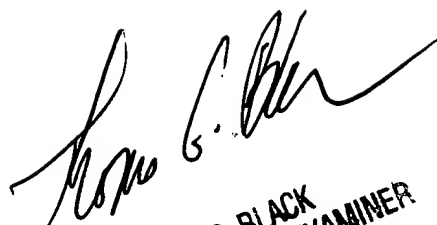
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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